

REMARKS

Claims 29 and 31 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Examiner Rachuba has agreed to withdraw this rejection (see paper no. 20081001).

New claims 38-44 are added. Support for the new claims is provided by pages 1, 7-8 and Figs. 1-7 of the originally-filed application.

Claims 21, 22, 24-28 and 32-37 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Allen et al. 2,879,632. Claims 16-20 and 29-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mandler, 5,951,376 in view of Allen et al, 2,879,632.

Independent claim 16 is rejected on the combination of Mandler and Allen. Of the combination, the Examiner relies on Mandler to allege a teaching to the positively recited "connecting material" of the following limitation claim 16: "the spectacle lens *is secured to a first holder **by connecting material***." (pgs. 3-4 of office action, paper no. 20080508). The Examiner states Mandler teaches a "seal and vacuum" that "together they connect the lens to the holder," and therefore the Examiner argues, the "seal and vacuum" teach the positively recited **connecting material** of claim 16. However, Mandler fails to teach either a "seal" or "vacuum", separately or in any combination. In fact, an electronic search of Mandler verifies that neither "seal" nor "vacuum" are taught. Moreover, no teachings of Mandler suggest a "seal" or "vacuum." Consequently, the Examiner has failed to demonstrate a teaching or suggestion to a positively recited limitation of claim 16 ("obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re*

Royka, 490 F.2d 981, 985 (CCPA 1974)). Having failed to demonstrate a teaching to all the limitations of claim 16, independent claim 16 is allowable.

Still further regarding the rejection against independent claim 16, claim 16 recites “**aligning** said spectacle lens relative a second holder *using the marking* of the adapter part.” Of the combination, the Examiner states Mandler fails to teach this limitation and relies on Allen. Particularly, the Examiner relies on prism markings 126 of Allen to allege a teaching to the positively recited “marking of the adapter part” positively recited by claim 16. However, the prism markings 126 of Allen are used for tilting a lens to provide a “prism” setting in a surface of lens (col. 1, lines 28-41) during machining of the surface. That is, forming an angle in the surface of the lens by machining the surface (col. 5, line 59 to col. 5, line 10). However, in no reasonable interpretation does providing “prism” settings in a lens surface teach or suggest “**aligning** said spectacle lens relative a second holder” as positively recited by claim 16. There is simply is no teaching of a coordination or relationship between the tilting of the lens of Allen relative a second holder wherein an aligning is possible. Accordingly, without more, no aligning is taught or suggested. Consequently, the combination of Mandler and Allen has failed to teach another positively recited limitation of claim 16, and therefore, independent claim 16 is allowable for this deficiency in teachings alone.

Still further regarding the rejection against independent claim 16, the Examiner is reminded that the U.S. Supreme Court recently addressed the question of obviousness regarding claims directed to a combination of known elements, *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007) and stated:

...a court must ask whether the improvement is more than the predictable use of prior art elements according to their

established functions.... Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, **there must be some articulated reasoning with some rational underpinning** to support the legal conclusion of obviousness”).

KSR, 127 S. Ct. at 1740-1741, 82 USPQ2d at 1396 (emphasis added).

Respectfully, the Examiner states a “mere conclusory statement” for the rationale of combining Mandler and Allen for which the Supreme Court explicitly states is inappropriate for obviousness. The Examiner states: “Because both references teach method (sic) of holding a lens block for processing a lens, it would have been obvious to one of ordinary skill to have substituted the adapter of ‘632 for that of ‘376, for the predictable result of accurately aligning the lens with the second holder.” (page 4 of paper no. 20080508). The determination that the Examiner’s statement is merely a conclusion becomes obvious when a review of the references shows that the Examiner’s statement “for the predictable result of accurately aligning the lens with the second holder” does not exist. The prism markings 126 of Allen are used for tilting a lens to provide a “prism” setting in a surface of lens (col. 1, lines 28-41) during machining of the surface (col. 5, line 59 to col. 5, line 10) as discussed previously. Providing “prism” settings in a lens surface has no relevance to an aligning. In fact, Allen provides no teaching of a coordination or relationship between markings taught by

Allen for prism settings with markings or structure of a second holder. Therefore, is no teaching or suggestion for the Examiner's conclusory statement to a "predictable result of accurately aligning the lens with the second holder." How would the prism settings of Allen provide alignment with other structures? Where is the rational underpinning required by the U.S. Supreme Court? The Examiner has failed to provide the "articulated reasoning **with some rational underpinning** to support the legal conclusion of obviousness" as is required by the U.S. Supreme Court. Accordingly, the combination of Mandler and Allen is inappropriate and fails for supporting an obviousness rejection. For this reason alone the obviousness rejection against independent claim 16 fails and should be withdrawn. Independent claim 16 is allowable.

Claims 17-20, 29-30 and 38-41 depend from independent claim 16, and therefore, are allowable for depending from an allowable independent claim.

Dependent claim 29 recites "wherein the positioning of said first holder comprises providing a collet chuck in physical contact with the connecting material." The Examiner provides **no** prior art to reject this claim and simply states there is no disclosure to support this limitation (page 5 of paper no. 20080508). However, in an Examiner interview, the Examiner has agreed that there is support in the disclosure (see paper no. 20081001). Moreover, since the art of record fails to teach or suggest this limitation, dependent claim 29 is allowable.

Regarding the rejection against independent claim 21 based on Allen, the claim recites "markings align said spectacle lenses relative other structures." The Examiner relies on prism markings 126 of Allen to allege a teaching to the positively recited

limitation of claim 21. However, the prism markings 126 are used for tilting a lens to provide a “prism” setting in a surface of lens (col. 1, lines 28-41) during machining of the surface (that is, an angle in the surface of the lens upon machining) (col. 5, line 59 to col. 5, line 10). Providing “prism” settings in a lens surface is not “**aligning** said spectacle lens relative a second holder” as positively recited by claim 21. There is simply no teaching of a coordination or relationship between the tilting of the lens of Allen relative a second holder wherein an aligning is possible. Accordingly, without more, no aligning is taught or suggested. Consequently, Allen fails to teach a positively recited limitation of claim 21, and therefore, independent claim 21 is allowable for this deficiency in teachings.

Claims 22, 24-25, 31-32 and 42 depend from allowable independent claim 21, and therefore, the dependent claims are allowable for depending from an allowable independent claim.

Dependent claim 22 is amended to recite “wherein said alignment reference comprises a transverse web extending generally **perpendicularly** to an optical axis of the spectacle lenses.” Support for the amendment language is provided by the originally-filed application at Fig. 6. The Examiner relies on locating pin 14 of Allen to allegedly teach the positively recited “alignment reference” of claim 22. However, Fig. 3 of Allen teaches the locating pin 14 is oriented generally parallel to an optical axis of lens blank 120, and not perpendicular as positively recited by claim 22. Consequently, Allen fails to teach or suggest “a transverse web extending generally **perpendicularly** to an optical axis of the spectacle lenses” as positively recited by claim 22, and therefore, claim 22 is allowable for this reason alone.

Regarding the rejection against independent claim 26 based on Allen, the claim recites “markings align said spectacle lenses relative other structures.” The Examiner relies on prism markings 126 of Allen to allege a teaching to the positively recited limitation of claim 26. However, the prism markings 126 are used for tilting a lens to provide a “prism” setting in a surface of lens (col. 1, lines 28-41) during machining of the surface (that is, an angle in the surface of the lens upon machining) (col. 5, line 59 to col. 5, line 10). Providing “prism” settings in a lens surface does not “**align** said spectacle lens relative other structures” as positively recited by claim 26. There is simply is no teaching of a coordination or relationship between the tilting of the lens of Allen relative other structures wherein an aligning is possible. Consequently, Allen fails to teach a positively recited limitation of claim 26, and therefore, independent claim 26 is allowable for this deficiency in teachings.

Claims 27-28, 33-35 and 43 depend from allowable independent claim 26, and therefore, the dependent claims are allowable for depending from an allowable independent claim.

Regarding the rejection against independent claim 36 based on Allen, the claim is amended to recite “an *alignment reference* extending generally **perpendicularly** to an optical axis of the spectacle lenses.” Support for the amendment language is provided by the originally-filed application at Fig. 6. The Examiner relies on locating pin 14 of Allen to allegedly teach the positively recited “alignment reference” of claim 36. However, Fig. 3 of Allen teaches the locating pin 14 is oriented generally parallel to an optical axis of lens blank 120, and not perpendicular as positively recited by claim 36. Consequently, Allen fails to teach or suggest “an *alignment reference* extending


generally **perpendicularly** to an optical axis of the spectacle lenses" as positively recited by claim 36, and therefore, independent claim 36 is allowable.

Claims 37 and 44 depend from independent claim 36, and therefore, are allowable for depending from an allowable independent claim.

This application is now believed to be in immediate condition for allowance and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

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